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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,760	08/25/2003	Maria Adamczyk	0201-99036 CON	2784
33939	7590	03/07/2006	EXAMINER	
NORA M. TOCUPS P.O BOX 698 140 PINECREST AVE DECATUR, GA 30030			PATEL, HEMANT SHANTILAL	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/647,760		ADAMCZYK ET AL.	
	Examiner		Art Unit	
	Hemant Patel		2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 0203.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-16 are cancelled. Claims 17-20 are pending in this application.

Specification

1. The disclosure is objected to because of the following informalities: The parent application and corresponding patent number are not specified.

Appropriate correction is required.

Claim Objections

2. Claim 17 is objected to because of the following informalities: The word "relyted" is incomprehensible. The Examiner has interpreted it as "relayed". Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2645

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 17-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,650,740 B1 (Parent of instant application) because claims in the continuation are broader than one in parent. *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761, broad claims are rejected as obvious double patenting over previously patented narrow claims. The claim 17 is broader in scope than the claim 1 of parent patent No. 6,650,740 B1. The preamble of claim 17 is broader than the specific preamble of claim 1. The broad receiving steps (i.e. receiving transfer of a communication and receiving a message) of claim 17 are the same as the patented step A of claim 1 except that claim 17 does not specifically recite "the release of the subscriber's communication by the VMS". Also the making and bridging steps of claim 17 are the same as step C of claim 1 except that the specific feature of "INE" recited in step C of the claim 1 was not recited in claim 17.

Regarding Claim 19, its preamble is clearly boarder than the preamble of claim 6 of parent U.S. Patent No. 6,650,740 B1. The body of claim 19 recites "a network element" which broadly covers the patented SCP and INE of claim 6 of U.S. Patent No. 6,650,740 B1, and the claimed features performed by network element of claim 19 are identical with the features performed by SCP and INE of claim 6 of U.S. Patent No. 6,650,740 B1 respectively. Thus claim 19 is broader in scope than patented claim 6.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 17, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Dugan (US patent No. 6,330,079 B1).

Regarding claim 17, Dugan teaches of a method to make a reply call to a voice mail message, comprising:

receiving transfer of a communication that relayed the voice mail message (col. 15, ll. 60-67, transfer to ACD);

receiving a message indicating a reply call to the voice mail message (col. 15, 65-67, “#” DTMF tone for 1.5 seconds);

making a call to the reply telephone number (col. 16, ll. 9, ARU establishes the call); and

bridging the communication that relayed the voice mail message with the call to the reply telephone number to form the reply call. (col. 16, ll. 9-10, establishing the call between the subscriber and the guest caller).

Regarding claim 19, Dugan teaches of a system for making a reply call to a voice mail message, comprising:

a network element operative to receive a transfer of a communication that relayed a voice mail message (Fig. 1B, item 33, col. 8, ll. 22-25, 15, ll. 60-65, ACD receiving transfer call).;

the network element operative to receive a message indicating a reply call to the voice mail message is to be directed to a reply telephone number (col. 15, 65-67, “#” DTMF tone for 1.5 seconds);

the network element operative to cause a call to the reply telephone number to be made (col. 15, ll. 67-col. 16, ll. 10, ACD causing ARU to establish callback call); and

the network element operative to cause the communication that relayed the voice mail message to be bridged to the call to the reply telephone number to form the reply call (col. 15, ll. 67-col. 16, ll. 10, ACD causing ARU to establish call between the subscriber and the guest caller).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan as applied to claims 17, 19 above, and further in view of Jordan (US Patent No. 4,313,035).

Art Unit: 2645

Regarding claims 18, 20, Dugan teaches of a re-origination request from the recipient to initiate callback (inherently any origination request would have the originator identity i.e. identifier for the callback (reply) call). ARU determines this as re-origination request by accessing NIDS, which stores information on subscriber profiles and also queries VFP to get callback number for the called subscriber (col. 16, ll. 2-5). This inherently suggests that ARU received called subscriber number as parameter to re-origination request. Dugan automatically uses caller's ANI.

Dugan does not teach of explicitly receiving callback (reply) telephone number in a message.

However, in the same field of endeavor, Jordan teaches of expressly receiving a reply (callback) number (col. 9, 49-50, caller B leaving his number) and sending directory number of callback as part of callback request (col. 11, ll. 57-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Dugan to include explicitly receiving a callback number and sending it in a message to establish a callback call as taught by Jordan in order to be able to server a caller whose office does not support ANI (Jordan, col. 9, ll. 47-49).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Geen (US Patent No. 6,735,288 B1) Voice Over IP Voice Mail System
Configured For Placing An Outgoing Call And Returning Subscriber To Mailbox After
Call Completion

Ridgley (US Patent No. 6,195,418 B1) Telephone System Having A Callback
Capability And Method for Connecting a Recipient Of A Message To A Caller

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Hemant Patel whose telephone number is 571-272-
8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
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HSP
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Hemant Patel
Examiner
Art Unit 2645

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